

REMARKS

Claims 1-16 are pending following entry of the present Amendment.

INFORMATION DISCLOSURE STATEMENT

The Examiner has noted that the non-US patent references listed on the December 13, 2003, 1449 Form could not be found in the parent application. In reply, Applicants submit these references along with a new 1449 Form. Consideration of these references is respectfully requested.

OBJECTIONS TO THE CLAIMS

The Examiner has objected to claims 1-16 due to the misspelling of sulfonyl and fluor as well as the absence of semicolons.

Applicants submit that these objections have been obviated by the correction of the spellings of sulfonyl and fluoro as well as the addition of semicolons after each species name. Withdrawal of the objections is respectfully requested.

OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

Claims 1-16 were provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 87, 88, and 91 of copending application 10/980,199. In response, Applicants respectfully submit a terminal disclaimer over copending application 10/980,199 to obviate this double patenting rejection. Applicants note that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither a presumption nor estoppel on the merits of the rejection”. Quad Environmental Technologies Corp. v. Union Sanitary District, 20 USPQ 2d 1392 (Fed. Cir. 1991).

Claims 1-16 were rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 57-67 of US Patent No. 6,875,760 and claims 52-56 of US Patent No. 6,503,949. In response, Applicants respectfully submit terminal disclaimers (2) over these patents to obviate these double patenting rejections. Applicants note that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither a presumption nor estoppel on the merits of the rejection”. Quad Environmental Technologies Corp. v. Union Sanitary District, 20 USPQ 2d 1392 (Fed. Cir. 1991).

REJECTION UNDER 35 USC §102(e)

The Examiner rejected claims 1-16 as being anticipated under 35 U.S.C. §102(e) by Lau et al (US 6,503,949) because of the third compound in columns 501-502 of Lau et al.

Applicants submit that this rejection has been obviated by deletion of the compound noted by the Examiner (as well as Example 265 of Lau et al).

Withdrawal of the §102(e) rejection is therefore respectfully requested.

REJECTIONS UNDER 35 USC §103

The Examiner has rejected claims 1-16 under 35 USC §103(a) as being obvious over US patent 6,503,949, which is available under 35 U.S.C. 102 (e).

Applicants respectfully traverse this rejection. Applicants note that US patent 6,503,949 is disqualified under 35 USC §103(c) as prior art against the claimed invention as the subject matter thereof and the presently claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Accordingly, the undersigned hereby states that since the present application 10/712,465 and US 6,503,949 were, at the time the invention of application 10/712,465 was made, commonly owned by Novo Nordisk A/S and Agouron Pharmaceuticals Inc., US 6,503,949 is disqualified from being used in a rejection under 35 U.S.C. 103(a) against application 10/712,465. The evidence supporting common ownership of application 10/712,465 and US 6,503,949 is the Assignment at Reel 012657/Frame 0626 in application 10/712,465 and the Assignment at Reel 011657/Frame 0129 in US 6,503,949.

In view of the above statement by the undersigned and the evidence of common ownership, withdrawal of the obviousness rejection is respectfully requested.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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